



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,686	08/31/2001	Jeffrey T. Aguilera	10002629-1	2107

7590 11/16/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CHUONG, TRUC T

ART UNIT	PAPER NUMBER
----------	--------------

2179

DATE MAILED: 11/16/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,686

Applicant(s)

AGUILERA ET AL.

Examiner

Truc T Chuong

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-12,14 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-12,14 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2179

DETAILED ACTION

1. This communication is responsive to Amendment A, filed 08/05/04.
2. Claims 1-2, 4-6, 8-12, 14, and 17-19 are pending in this application. Claims 1, 23, 26, 28-29, and 36 are independent claims. This is made final.

Response to Amendment

3. The Declaration filed on 08/05/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Machida (U.S. Patent No. 6,642,943 B1).

The following parties may make an affidavit or declaration under 37 CFR 1.131:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

In this case, required by the law that inventor Mr. Jeffrey Aguilera has to sign on the Declaration.

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged.

Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

Art Unit: 2179

- (A) attached sketches;
- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);
- (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. *Ex parte Homan*, 1905 C.D. 288 (Comm'r Pat. 1905);
- (H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception. Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d). A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r

Art Unit: 2179

Pat. 1890) the court stated

i.e., If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others. Note the Exhibit 1 includes page 1 of 3 and 3 of 3, page 2 of 3 is missing.

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." *In re Asahi /America Inc.*, **>68 F.3d 442, 37 USPQ2d 1204, 1206< (Fed. Cir. 1995) (Citing *Newkirk v. *>Lulejian<*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to

Art Unit: 2179

practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

The facts to be established under 37 CFR 1.131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his or her remedy is by appeal from the continued rejection. See MPEP § 2138.04 through § 2138.06 for a detailed discussion of the concepts of conception, reasonable diligence, and reduction to practice. For the most part, the terms “conception,” “reasonable diligence,” and “reduction to practice” have the same meanings under 37 CFR 1.131 as they have in interference proceedings. However, in *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979), the court stated:

The purpose of filing a [37 CFR 1.131] affidavit is not to demonstrate prior invention, per se, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, “[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity.” *Id.* at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, “the conception’ and reduction to practice’ which must be established under the rule need not be the same as what is required in the interference’ sense of those terms.” *Id.*; accord, *In re Borkowski*, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974).

In the Exhibit 1, the Applicants have not clearly show in details how to solve the problem as stated in claims 1 and 14 of the application; and nowhere in the Exhibit 1 mentions a

Art Unit: 2179

duplicator, selectable icons, and selectable menu items. Claims do not appear to be supported by the evidence provided in claims. It means that there is not enough evidence to clearly prove the relationships between the Exhibit 1 and the Claims.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 4-6, 8-12, 14, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Webb et al. (U.S. Patent No. 5,727,135).

As to claim 1, Webb teaches a user interface comprising a simultaneous display of a plurality of first selectable icons each representing a different duplicator (buttons 303, 304, and 305 of fig. 8, e.g., col. 19 lines 18-40) and a second selectable icon (detail information about the active printer is displayed as icons, e.g., col. 19 lines 25-40, and fig. 8) that when selected actuates the respective actuates the duplicator(s) represented by a selection of one or more of the first selectable icons (e.g., col. 19 lines 30-59, and figs. 1, 2, & 8).

As to claim 2, Webb teaches the user interface as defined in Claim 1, wherein:

the simultaneous display of the selectable icons is a menu screen (e.g., col. 19 lines 25-40, figs. 1, 2, and 8); and

each selectable icon is a menu item (e.g., col. 7 line 54-col. 8 line 9, figs. 1, 2, & 8).

Art Unit: 2179

As to claim 4, Webb teaches the user interface as defined in Claim 1, wherein the actuation of the plural duplicators occurs in a chronological sequence selected by the user on the UI (if button 303 has been actuated/selected, the detailed information of the printer 16 is simultaneously provided to the user, and similar with 305, 304 corresponding to 16' and 16'', e.g., col. 19 line 24-56 and fig. 8).

As to claims 5-6, Webb teaches the user interface as defined in Claim 1, wherein the actuation of the plural duplicators selected by a user on the UI occurs simultaneously (it can be rejected under similar explanation as claim 4 above).

As to claim 8, Webb teaches the user interface as defined in Claim 1, wherein each said duplicator has the capability of performing one or more functions selected from the group consisting of printing, magnetic tape recording, photo imaging substrate recording, recording an optically scanned image onto a magnetic media storage device, magneto optical writing, and electromagnetic radiation broadcasting transmission (e.g., col. 19 lines 25-40 and figs. 1 & 8).

As to claim 9, Webb teaches the user interface as defined in Claim 8, wherein the printing is performed by a printer having the capability of performing one or more functions selected from the group consisting of dot matrix printing, thermal ink jet printing, laser printing, color printing, high quality photo reproduction, printing on substrates of varied composition, binding, collating, folding, stacking, stapling, stitching, edge trimming, and paginating (printer 16 is a laser printer but for purposes of the invention, the type of print head employed by printer 16 is immaterial. The invention is equally applicable to other electrophotographic printers as well as ink jet, wire matrix and other types, col. 6 lines 20-36).

Art Unit: 2179

As to claim 10, it is similar in scope to claim 1 above; therefore, rejected under similar rationale.

As to claim 11, it is similar in scope to claim 8 above; therefore, rejected under similar rationale.

As to claim 12, it is similar in scope to claim 9 above; therefore, rejected under similar rationale.

As to claim 14, it is a method claim of system claim 1. Note the rejection of claim 1 above.

As to claims 17-18, they are method claims of system claims 8-9. Note the rejection of claims 8-9 above respectively.

As to claim 19, this is a computer program product claim of method claim 14. Note the rejection of claim 14 above.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2179

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T Chuong whose telephone number is 571-272-4134. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Truc T. Chuong

11/03/04

BA HUYNH
PRIMARY EXAMINER